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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,112	03/21/2001	Petter Ericson	3782-0124P	8117
2292	7590	06/22/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUTTON JR, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,112

Applicant(s)

ERICSON ET AL.

Examiner

Doug Hutton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03292002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt of papers submitted under 35 U.S.C. 119(a)-(d) is acknowledged. The papers have been placed of record in the file.

Claim Objections

Claim 2 is objected to because of the following informalities:

- the term "the" should be inserted before the term "document information" in Line 5 because the document information is previously mentioned in the claim (see Line 4).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 15-18, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412.

Claim 1:

Henderson discloses a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- transferring document information to a printing device adapted to print the document information on a surface (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic document editing system allows a user to send a document to a printer so that the document is printed on paper);
- receiving editing information from a reading device adapted to read position information from the surface (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);
- interpreting the editing information (the electronic document editing system interprets the handwritten edit markings); and
- changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (the electronic document editing system converts the handwritten edit markings into digital form and combines the digitized edit with the electronic document).

Henderson fails to expressly disclose a printing device that prints the document information on a surface having a *position-coding pattern*.

Lazzouni teaches a method of editing a document (see Figures 1-13; see Column 1, Line 1 through Column 16, Line 65), the method comprising:

- a printing device that prints the document information on a surface having a position-coding pattern (the electronic document editing system allows the user to print a document on paper having a prerecorded pattern of pixels), for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include a printing device that prints the document information on a surface having a position-coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 2:

Henderson discloses a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- transferring document information to a printing device adapted to print the document information on a surface (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic document editing system allows a user to send a document to a printer so that the document is printed on paper);
- receiving editing information from a reading device adapted to read position information from the surface (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);
- interpreting the editing information (the electronic document editing system interprets the handwritten edit markings); and
- changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (the electronic document editing system converts the handwritten edit markings into digital form and combines the digitized edit with the electronic document).

Henderson fails to expressly disclose transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface.

Lazzouni teaches a method of editing a document (see Figures 1-13; see Column 1, Line 1 through Column 16, Line 65), the method comprising:

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- transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface (the electronic document editing system allows the user to print a document on paper having a prerecorded pattern of pixels),

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include transferring position-coded pattern information to a printing device adapted to print the position-coding pattern on a surface for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 3:

Henderson discloses a method according to Claim 1 or 2, further comprising receiving device identity information from the reading device, the identity information associating the editing information with a user of the reading device (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors).

Claim 4:

Henderson discloses a method according to Claim 1 or 2, wherein the editing information is associated with a plurality of users, and wherein each user generates at least one editing command with a reading device (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors).

Claim 6:

Henderson discloses the method according to Claim 1 or 2, wherein the editing information includes position information related to a position of the reading device on the surface, and wherein the interpretation of the editing information includes interpretation of the position information (the electronic document editing system records the positional information of the digitizer pen as the user edits the document; this information is used during interpretation of the edit markings).

Claim 7:

Henderson discloses the method according to Claim 6, wherein the position information is in the form of sequences of coordinates forming manually generated curves corresponding in form to drawn curves on the printed document (the positional information is in the form of X-Y coordinates used to form handwritten annotations written on the document by the user).

Claim 8:

Henderson discloses the method according to Claim 1 or 2, further comprising displaying the document information of the updated document to a user (the electronic document editing system displays the edited document).

Claim 9:

Henderson discloses the method according to Claim 1 or 2, wherein the step of changing the document information includes adding editing information in the form of handwritten annotations to the document (the electronic document editing system allows the user to make handwritten annotations to the document).

Claim 10:

Henderson discloses the method according to Claim 9, further comprising associating, based on position information included in the editing information, each of the handwritten annotations with a respective portion of the document information (the electronic document editing system incorporates annotations made on the document and displays them in corresponding locations).

Claim 11:

Henderson discloses the method according to Claim 1 or 2, wherein changing the document information includes reformatting one or more parts of the document

information (the electronic document editing system incorporates the edit markings into the electronic document).

Claim 12:

Henderson discloses the method according to Claim 11, wherein said reformatting is chosen from the group of:

- adding text or graphics to said document information; removing text or graphics from said document information; or repositioning text or graphics included in said document information.

Claim 13:

Henderson discloses the method according to Claim 12, wherein adding text includes converting part of the editing information to machine-readable text.

Claim 15:

This claim merely recites computer software that performs the method of Claims 1 or 2. Accordingly, Henderson, in view of Lazzouni, discloses/teaches every limitation of the claim as specified in the above rejections for Claims 1 and 2.

Claims 16 and 17:

These claims merely recite a computer system that performs the method of Claims 1 and 2, respectively. Accordingly, Henderson, in view of Lazzouni,

discloses/teaches every limitation of the claims as specified in the above rejections for Claims 1 and 2.

Claim 18:

This claim merely recites a computer system that performs the method of Claim 3. Accordingly, Henderson, in view of Lazzouni, discloses/teaches every limitation of the claim as specified in the above rejection for Claim 3.

Claim 22:

Henderson discloses a method of editing a document containing information (see Figures 1-5; see Column 1, Line 1 through Column 18, Line 55), the method comprising:

- storing the document information in memory (see Column 2, Line 40 through Column 3, Line 22; see Column 3, Line 46 through Column 12, Line 39 – the electronic document editing system runs on a computer system);
- printing the document information on a surface (the electronic document editing system allows a user to send a document to a printer so that the document is printed on paper);
- enabling an electronic pen to physically mark edit instructions on the surface and to electronically capture the edit instructions (the electronic document editing system allows the user to fix the paper document to a digitizer and edit the document using a digitizer pen);

- receiving through a processor associated with the memory the edit instructions captured by the electronic pen (the electronic document editing system interprets the handwritten edit markings); and
- altering the document information in memory to conform to the edit instructions (the electronic document editing system combines the digitized edit with the electronic document).

Henderson fails to expressly disclose:

- a surface that contains a readable code contained thereon in addition to the printed document information; and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions.

Lazzouni teaches a method of editing a document (see Figures 1-13; see Column 1, Line 1 through Column 16, Line 65), the method comprising:

- a surface that contains a readable code contained thereon in addition to the printed document information (the electronic document editing system allows the user to print a document on paper having a prerecorded pattern of pixels); and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions (the electronic document editing system receives edit markings made by the user and positions the edits according to their proximity to the pattern of pixels),

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to include:

- a surface that contains a readable code contained thereon in addition to the printed document information; and
- capturing the edit instructions by reading the readable code proximate the marked edit instructions,

for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 23:

Henderson fails to expressly disclose a readable code that is a position coding pattern.

Lazzouni teaches a readable code that is a position coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, to

include a readable code that is a position coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer, as taught in Lazzouni.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412, and further in view of Moody et al., U.S. Patent No. 5,890,177.

Claim 5:

As indicated in the above discussion, Henderson, in view of Lazzouni, discloses/teaches every element of Claim 4. Henderson also discloses editing commands that are generated by the plurality of users in an ordered sequence (the electronic document editing system allows multiple remote users to analyze a document during a teleconference and make edits to the document; the individual users are identified using different pen colors, and their edits are stored in the system).

Henderson, in view of Lazzouni, fails to expressly disclose editing commands identified by at least a timestamp associated with each editing command.

Moody teaches a method of editing a document (see Figures 1-5; see Column 1, Line 1 through Column 14, Line 40), the method comprising:

- editing commands generated by a plurality of users that are in an ordered sequence identified by at least a timestamp associated with each editing

command (the electronic document editing system records a timestamp that indicates when the edits were made by each of the plurality of users), for the purpose of determining when a particular edit was made.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include editing commands generated by a plurality of users that are in an ordered sequence identified by at least a timestamp associated with each editing command for the purpose of determining when a particular edit was made, as taught in Moody.

Claims 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, U.S. Patent No. 5,897,648, in view of Lazzouni et al., U.S. Patent No. 5,652,412, and further in view of Dymetman et al., U.S. Patent Application Publication No. US 2002/0020750 A1.

Claim 14:

As indicated in the above discussion, Henderson, in view of Lazzouni, discloses/teaches every element of Claims 1 or 2. Lazzouni also discloses initially registering said document in a pattern administration unit, wherein said pattern administration unit assigns a unique subset of said position-coding pattern (the electronic document editing system uses different coding algorithms for different

patterns that are placed onto each paper document; the system stores each of these different patterns when they are created).

Henderson, in view of Lazzouni, fails to expressly disclose a pattern administration unit that assigns a unique subset of said position-coding pattern *to each page of said document*.

Dymetman teaches a method of editing a document (see Figures 1-15; see Paragraphs 0001-0364), the method comprising:

- a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document (the document editing system uses dataglyphs to identify particular pages and to specify a function to be performed regarding that particular page),

for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Henderson, in view of Lazzouni, to include a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page, as taught in Dymetman.

Claim 19:

This claim merely recites a computer system that performs the method of Claim 14. Accordingly, Henderson, in view of Lazzouni, and further in view of Dymetman, discloses/teaches every limitation of the claim as specified in the above rejection for Claim 14.

Claim 20:

Henderson discloses a means for receiving editing information that is included in a pattern administration unit (the document editing system receives and collects and stores the edits from the multiple remote users).

Claim 21:

Henderson discloses a means for receiving editing information that is included in a local processing unit (the document editing system receives and collects and stores the edits from the multiple remote users).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lazzouni et al., U.S. Patent No. 5,661,506; Wolff et al., UK Patent Application No. 2306669 A; and Borgstrom et al., U.S. Patent No. 6,738,053.

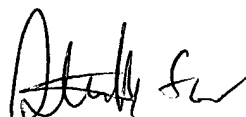
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
June 5, 2004



**HEATHER HERNDON
SUPERVISORY PATENT EXAMINER
TECH CENTER 2100**